

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Motoo SUMIDA et al.) Confirmation No.: 5291
Application No.: 10/527,703)
Filed: October 13, 2005) Group Art Unit: 1657
For: PROCESS FOR PRODUCTION OF)
TRANSESTERIFIED OILS/FATS OR) Examiner: Herbert J. Lilling
TRIGLYCERIDES)

PETITION UNDER 37 C.F.R. § 1.144

Mail Stop: AMENDMENT
Commissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22314

Sir:

This petition is filed in response to the non-final Office Action mailed June 5, 2009, in the application above. This petition is properly filed under 37 C.F.R. § 1.144, because Petitioner requests revision of restriction requirement, including rejoinder of claims withdrawn from consideration, and because no appeal has been filed yet in this application. *See* 37 C.F.R. § 1.144. If the Office believes there are fees outstanding, or if necessary to maintain pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573.

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STATEMENT OF FACTS

- F.1 The present application is a national stage application filed under 35 U.S.C. § 371.
- F.2 On 8 November 2007, the Examiner issued a Requirement for Restriction/Election that included an election of species. The Examiner revised the Requirement in a communication mailed 29 November 2007. The Requirement set forth the following Groups:

Group I, claims 1-9 and 21-23, directed to a process of making a product;

Group II, claims 10-16 and 22,* directed to a product;

Group III, claim 17, directed to a product;

Group IV, claim 18, directed to a product;

Group V, claim 19, directed to a product;

Group VI, claim 20, directed to a product;

Group VII, claims 25-26, directed to a product;

Group VIII, claim 27, directed to a product;

Group IX, claims 28-29, directed to a product; and

Group X, claim 30, directed to a product.

* To expedite prosecution, Petitioners considered claim 22, which is directed to a process, as properly belonging solely to Group I.

F.3 On 2 May 2008, Petitioners filed a Response with an election of Group II, claims 10-16, *with traverse* and an election of a species *with traverse*.

F.4 On 3 July 2008, the Examiner issued a Notice of Non-Responsive Amendment (now vacated) and revised and clarified the species election.

F.5 On 4 August 2008, Petitioners filed a response to the species election mailed 3 July 2008, along with a summary of the contents of an interview with the Examiner held on 16 July 2008.

F.6 On 5 June 2009, the Examiner mailed a first Office Action on the merits. The Examiner noted the election of Group II, claims 10-16, and the election of a species allegedly encompassed by claims 10 and 14. The Examiner withdrew claims 1-9, 11-13, and 15-30 from consideration.

The Examiner rejected claims 10 and 14 under 35 U.S.C. §§ 102 and 103 over various references.

F.7 On 19 and 22 October 2009, Petitioners requested the Examiner to rejoin at least claim 11, as amended in a proposed amendment.

F.8 On 23 October 2009, the Examiner issued an Interview Summary (1) officially vacating the Notice of Non-Responsive Amendment mailed 3 July 2008, and (2) denying Petitioners' request to rejoin at least withdrawn claim 11, as amended.

F.9 In the concurrently filed Amendment and Response under 37 C.F.R. § 1.111, Petitioners amend the claims without prejudice or disclaimer to expedite prosecution and facilitate rejoinder. Amended claims 11-16 and 27-30 are directed to the product of claim 11 or compositions comprising the product of claim 11. Claims 1-9 and 21-23 are directed to a process for producing the product of claim 11.

POINTS TO BE REVIEWED

Petitioners respectfully request (1) rejoinder of claim 11 for further examination on the merits with claim 14, and (2) reorganization of the Groups into Group I, claims 1-9 and 21-23, and Group II, claims 11-16 and 27-30.

For the purpose of compact prosecution and administrative economy, Petitioners also request (3) revision of the PAIR entry for 3 July 2008 to reflect the vacated Notice of Non-Responsive Amendment. Finally, Petitioners request (4) the Office to provide a full translation of three references relied upon in its rejection. *See* F.6.

(1) To comply with PCT rules, claim 11 must be rejoined and examined on the merits.

PCT Rule 13.2 is interpreted in the International Search and Preliminary Examination Guidelines, revised March 25, 2004 ("ISPE Guidelines"). ISPE Guidelines, ¶ 10.06 states that unity of invention is "considered in the first place only in relation to the *independent* claims." The Office must carefully consider the prior art to determine whether the independent claim avoids the prior art, before raising an objection over lack of unity for the dependent claims. ISPE Guidelines, ¶ 10.08.

In the present case, claim 11 is the only independent claim. F.9. Therefore, unity of invention must be determined with respect to claim 11, and the Examiner must consider whether claim 11 avoids the prior art to comply with ISPE Guidelines, ¶¶ 10.06 and 10.08. Further, a generic claim (i.e., claim 11) encompassing the elected species (e.g., claim 14) must be examined along with the elected species to comply with MPEP § 809.¹ Accordingly, Petitioners request rejoinder of claim 11 and examination on the merits of claims 11 and 14.

In the Interview Summary, the Examiner alleges that claim 11 may not be enabled. Under PCT rules, unity of invention is determined solely with respect to the prior art. *See Rule 13.2; ISPE Guidelines, ¶¶ 10.01, 10.02.* Accordingly, the Examiner's allegations regarding enablement under 35 U.S.C. § 112, first paragraph, have no relevance to unity of invention or rejoinder.

- (2) **The Office should group product claims 11-16 and 27-30 in a single Group and should indicate that all claims will be eligible for rejoinder, once a special technical feature is identified in claim 11.**

Petitioners do not request rejoinder of claims 1-9, 12-13, 15-16, 21-23, and 27-30 at this time. For the reasons set forth above, PCT rules mandate rejoinder of all the claims upon a finding that claim 11, the only independent claim, recites a special technical feature. Claim 11 is broader in scope than claim 14. Logically, the pending rejections against claim 14 should apply to claim 11. Until the Office acknowledges a special technical feature in claim 11, Petitioners understand that full rejoinder may be premature.

Petitioners, however, request a simplification of the restriction requirement to expedite subsequent prosecution. The Examiner alleges that the process of claims 1-9 and 21-23 constitutes an independent and distinct invention. F.2. Product claims 11-16 and 27-30 likewise should be grouped as a single Group of inventions. The product claims share overlapping subject matter, and thus do not constitute multiple distinct inventions, as alleged. *See, e.g., MPEP § 806.03.* The process of claims 1-9 and 21-23 arguably is independent and distinct from the

¹ *See, e.g., In re Application of Okuno et al.,* Application No. 10/573,821, filed March 28, 2006, Decision on Petition, at *2-3 (Director, TC1600 October 13, 2009) (non-precedential) (applying MPEP § 809 in a national stage application).

product of claims 11-16 and 27-30. *See F.2.* Petitioners thus request the Groups of inventions be reorganized as follows:

Group I, claims 1-9 and 21-23; and

Group II (elected), claims 11-16 and 27-30.

The Office is requested to indicate that Group I should be rejoined with elected Group II, once the Office acknowledges a special technical feature in claim 11. A national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to a product and a process specially adapted for the manufacture of the product. 37 C.F.R. § 1.475(b)(1). In the present case, Group I is drawn to a process of making the product of Group II. The two Groups are related as a product and a process specially adapted for the manufacture of the product. All the claims thus are eligible for rejoinder under 37 C.F.R. § 1.475(b)(1).

(3) Other requests.

Petitioners note that the Notice of Non-Responsive Amendment mailed 3 July 2008 is vacated. PAIR, however, still reflects the entry of a Notice of Non-Responsive Amendment. A USPTO audit of Patent Term Adjustment will presume that the Notice was issued correctly, unless the PAIR entry is revised and updated. Accordingly, Petitioners request the PAIR entry be changed to "Miscellaneous Communication."

Finally, Petitioners request the Office provide a full translation of three references used in a rejection. *See Ex parte Bonfils*, 64 USPQ2d 1456, 1460 (Bd. Pat. App. Int. 2002) ("When the examiner, as here, relies on a document that is in a foreign language, the examiner bears the burden of providing an English translation, at the latest, before forwarding the appeal to the board.") The relevant references are:

D1: JP 10-290699;

D2: Tane *et al.*, *J. Jpn. Oil Chem. Soc.* 46: 785 (1997); and

D3: JP 2000-004894.

ACTIONS REQUESTED

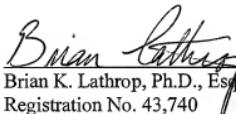
For the reasons above, Petitioners respectfully urge the Office to grant Petitioners' following requests:

- (1) rejoinder of claim 11 for further examination on the merits with claim 14;
- (2) reorganization of the Groups into Group I (claims 1-9 and 21-23) and Group II (claims 11-16 and 27-30);
- (3) revision of the PAIR entry for 3 July 2008 to reflect the vacated Notice of Non-Responsive Amendment; and
- (4) provision by the Office of a full translation of the references identified as D1, D2, and D3 above.

Respectfully submitted,

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Dated: Dec. 7, 2009

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